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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,783	06/19/2000	Carl J. Kraenzel	LOT9-2000-0006 US1	3747

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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,783

Applicant(s)

KRAENZEL ET AL.

Examiner

Sathyanarayan Pannala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 January 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because they fail to show necessary textual labels of features or symbols in Figs. 24 as described in the specification. For example, placing an arrow between elements to indicate direction of flow of Fig. 24, would give the viewer necessary detail to fully understand this process flow at a glance. A descriptive textual label for each numbered element in these figures would be needed to fully and better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. Optionally, applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.83. 37 CFR 1.84(n)(o) is recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

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2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-2, 4-22 are rejected under 35 U.S.C. 102(e) as being anticipated by McGee (US Patent 6,393,468).

5. McGee anticipated independent claims 1, 6, 7, 21 by the following:

“a database for storing user passwords” at Fig. 3, col. 7, lines 65-67;

“a plurality of subscriptions, each identified by a subscription user credential
“including password, user name and authentic table electronic certificate” at
Fig. 3, col. 8, lines 4-16;

“a service manager for executing concurrent replication of a plurality of said
subscriptions on schedule or demand for which a password corresponding to
said subscription credential has been provided by a user or found in said
database” at Fig. 3, col. 8, lines 16-37.

6. As per dependent claim 2, McGee anticipated by the following:

“a plurality of web-enabled, offline subscriptions each identified by user
credentials including user identifier and subscription password” at Fig. 3, col. 9,
lines 10-21;

“a service manager for displaying to a user a plurality of said subscriptions, for
enabling user selection of replication parameters for each said subscription, and
for maintaining replication schedules for said subscriptions” at Fig. 3, col. 9,
lines 22-39;

“a utility responsive to user input for concurrently replicating on schedule or
demand subscriptions for which said user has entered a user password matching
said subscription password” at Fig. 3, col. 9, lines 40-49.

7. As per dependent claim 4, “plurality of web enabled, offline subscriptions are
from multiple servers and from multiple user identities, and selectively having separate
database groupings and synchronization rules and properties” at Fig. 4 & 6, col. 11,
line 56 to col. 12, line 29.

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8. As per dependent claim 5, McGee anticipated by the following:
“a user password database for optionally storing said user password for each of said plurality of subscriptions” at Fig. 3 & 4, col. 10, lines 12-43;
“said utility being selectively responsive to a matching user password in said password database for replicating a corresponding subscription and responsive to no matching user password in said password database for prompting for user input of said user password before replicating said corresponding subscription” at Fig. 4 & 5, col. 10, line 63 to col. 11, line 12.
9. As per the independent claims 8, 14, 22, McGee anticipated by the following:
“a database of security domains” at Fig. 3, col. 8, lines 38-48;
“system electronic certificates for authenticating user credentials” at Fig. 3 & 4, col. 10, lines 12-18;
“a tool responsive to said database and said certificates for distributing user identifiers selectively based upon security domain through auto generation, directory lookup or user prompt” at Fig. 6, col. 11, lines 56-67.
10. As per dependent claims 9, 15, McGee anticipated by the following:
“an identifier repository database” at Fig. 6, col. 12, lines 17-18;
“a security domain document in said database of security domains for use in locating in said identifier repository database a user identifier selected for distribution based upon directory lookup” at Fig. 6, col. 12, lines 19-29.
11. As per dependent claims 10, 16, “a security domain document from said database of security domains for specifying an electronic certificate for use in auto

generating a user identifier selected for distribution based upon auto generation” at Fig. 6, col. 11, lines 45-67.

12. As per dependent claims 11, 17, “prompt code for execution in response to a need for a user entered user identifier” at Fig. 3, col. 10, lines 14-18.

13. As per dependent claim 12, 18, “a security model for enabling the distribution of previously deployed user identifiers by table lookup” at Fig. 3-4 & 8, col. 12, lines 58-63.

14. As per dependent claims 13, 19, McGee anticipated by the following:

“prompt code for execution in response to a need for a user entered user identifier” at Fig. 3, col. 10, lines 14-18;

“a security model for enabling the distribution of previously deployed user identifiers by table lookup” at Fig. 3-4 & 8, col. 12, lines 58-63.

15. As per the independent claim 20, McGee anticipated by the following:

“providing a database of security domains” at Fig. 3, col. 8, lines 38-48;

“responsive to said database, distributing user identifiers selectively based upon security domain through auto generation, directory lookup or user prompt” at Fig. 6, col. 11, lines 45-67.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

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prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made."

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGee (US Patent 6,393,468) as applied to claims above, and further in view of Forbes et al. (US Patent 6,381,742).

18. As per dependent claim 3, McGee does not teach explicitly the disk space needed for the document on the internet. However, Forbes teaches "service manager further displaying disk space usage for enabling user limitation of usage or removal of said subscription" (at col. 12, line 29 to col. 14, line 3). Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to include information on disk space needed to access an internet document in order to check the disk space on the client computer.

Response to Arguments

19. Applicant's arguments filed 3 January 2003 have been fully considered but they are not persuasive is described as below:

First, in response to applicant's argument that the servers that store passwords put all those passwords at risk if hacked, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

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otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Second, the applicant states as "there is no teaching in McGee of a 'subscription', as applicants have defined the term." McGee teaches the concept of subscription (see McGee at Fig. 3, col. 7, line 65 to col. 8, line 37).

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McGee and Forbes references are combined since both teach the same concept of authentication for internet access, where as Forbes explicitly discloses to the user the space needed to access a web file (see Forbes at col. 12, line 29 to col. 14, line 3).

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

22. If a reference indicated, as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (703) 305-3390. The examiner can normally be reached on 8:00 am - 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

SRP
Sathyanarayan Pannala
Examiner
Art Unit 2177

srp
February 24, 2003


GRETA ROBINSON
PRIMARY EXAMINER